

REMARKS

This is in response to the Official Action currently outstanding with respect to the above-identified application, which Official Action the Examiner has designated as being FINAL.

Claims 1-30 are pending in this application. Claims 1-19 have been withdrawn from further consideration in view of Applicants' response to the Examiner's Restriction Requirement. Claims 29-30 have been withdrawn from further consideration in the currently outstanding FINAL Official Action by the Examiner on the basis that Claims 29-30 are directed to a non-elected invention (Applicants having constructively elected the invention of Claims 20-28 by virtue of the issuance of a substantive action on the merits of those claims). By the foregoing Amendment, Applicants propose the amendment of Claims 20 and 25. Applicants do not propose either the addition or the cancellation of any claims by the foregoing Amendment. Accordingly, in the event that the Examiner grants entry of the foregoing Amendment, Claims 20-28 will constitute the claims under active prosecution in this application.

A version of the claims as they will stand upon the entry of this amendment is set forth above as required by the Rules.

More specifically, it is noted that in the currently outstanding Official Action, the Examiner has:

1. Acknowledged Applicants' claim for foreign priority and the receipt by the United States Patent and Trademark Office of the required certified copies of the priority document.

2. Informed the Applicants that the drawings filed on 26 September 2000 in this application are deemed to be acceptable.
3. Provided Applicants with a copy of a Notice of References Cited (a copy of the cited reference having been previously provided).
4. Acknowledged Applicant's Information Disclosure Statements of 6 February 2001, 17 December 2003 and 10 March 2004, in the text of the currently outstanding Official Action, but failed to provide Applicants with a copy of the Forms PTO-1449 that accompanied those Statements duly signed, dated and initialed by the Examiner to confirm his consideration of the art disclosed therein – **Applicants respectfully request signed, dated and initialed copies of the Forms PTO-1449 that accompanied their Information Disclosure Statements in response to this communication.**
5. Confirmed Applicants' belief that Claims 20-28 constitute the claims currently under active prosecution in this application.
6. Required Applicants to provide a substitute specification including claims incorporating all of the previously allowed amendments thereto in view of the substantial number of amendments thereto – **Applicants are attaching hereto a substitute specification incorporating all of the amendments thereto set forth in the Amendment of 18 March 2004 in this application.**
7. Finally rejected Claims 20-28 under 35 USC 102(b) as being anticipated by the Wilson reference (U.S. Patent No. 5,195,092).

8. Provided Applicants with a response to their previously filed arguments.

With respect to items 1-6 and 8 above, Applicants believe that further comment in these Remarks is not necessary.

With respect to item 7, the Examiner's substantive rejections of elected Claims 20-28 are based upon an alleged anticipation of those claims under the terms of 35 USC 102(b) by the Wilson reference (US Patent No. 5,195,092). In this regard, the Examiner's principal points are that (i) the wording of the preamble of Claim 20 is found in the Abstract of the Wilson reference; (ii) the first determining apparatus is found at least at Column 7, lines 1-31 of the Wilson reference; and (iii) the control apparatus is found at least at Fig. 2 and Claim 13 of the Wilson reference. The Examiner also alleges that Claim 21 is anticipated on the basis of Wilson's Fig. 2 showing the data of the cited reference is displayed on a television set. Further, the Examiner indicates a belief that urging a user to enter reproducing apparatus ID information responsive to a determination by the first determination apparatus that the reproducing apparatus ID information does not match the apparatus specifying ID information embedded in the input data is disclosed by Wilson at least at Column 2, lines 34-58. Still further, the Examiner contends that the concepts (i) of comparing the user entered reproducing apparatus ID information with the ID information embedded in the input data and (ii) of permitting the user to update the reproducing apparatus ID information according to his input ID information when his input allows reproduction of the input information are shown respectively at Column 7, lines 1-31, and at Column 21, lines 5-42 of the Wilson reference.

Applicants continue to find the Examiner's rejections to be somewhat confusing. This is because the present invention contemplates that the data to be reproduced is to be individually selected by the user at the time of use of the apparatus, and that the reproduction of that data is to be limited to a **uniquely designated reproduction apparatus**. Accordingly, in using the present invention, the user specifically selects data from various sources, "marks" that data with his own "ID" corresponding to the "ID" of the particular reproduction apparatus he wishes to use to reproduce that "marked" data, permissibly stores the data in an external storage, and reproduces the so "marked" data **provided that reproduction is not precluded by the "control apparatus"** (for example, because of overriding copyright or other proprietary considerations also reflected in "ID" information embedded in the information marked for reproduction).

In his Final rejection of currently pending Claims 20-28 the Examiner characterizes the configuration disclosed by Figure 2 of the Wilson reference as being a reproduction apparatus comparable to that of the present invention. Consequently, under the Examiner's interpretation, Claims 20-28 of the present application are broad enough to include a "reproduction apparatus" that includes apparatus associated with the initial reception and distribution of the claimed digital data as well as apparatus for the actual reproduction of the digital data.

According to the Examiner's analysis, therefore, the so-called "presentation players 54" of the Wilson reference constitute the "determining apparatus" being claimed.

This conclusion is apparently based on the fact that the "presentation players 54" are used to "determine" whether the actual reproduction apparatus (i.e., the user's television display) is capable of reproducing the digital data using the reproduction apparatus ID information associated with the presentation player and the reproducing apparatus specifying information embedded with the digital data. In fact, however, the presentation player "locks onto" the channel carrying the digital information having the reproducing apparatus specifying information that matches the presentation player's ID information. This is clearly the case because after the presentation player receives the digital data having the matching apparatus specifying information to its own ID information, the presentation player converts the incoming data into a form viewable on the user's television and sends that converted information out to the user's (and permissibly other's) television display without the exercise of further "determination" or "control".

The "control apparatus" claimed, on the other hand, is deemed by the Examiner to be the equivalent of the "means for preferentially multiplexing and distributing said stream of data from said stream data sources into a selected distribution channel..." as set forth in Wilson's Claim 13 (see Column 47, lines 20-25 of Claim 13 of the Wilson reference). The result of this line of reasoning, however, is that the only feature of the Wilson reference that "controls" what information is to be reproduced by the reproduction apparatus is found at the CATV headend (i.e., during the original assembly of the data signals that are to be sent out with distinct and unique ID's to the various "presentation players" (prior to any "determination" by the presentation players regarding which data channel includes apparatus specifying information matching its ID information).

Applicants respectfully submit that if the Examiner's conclusions in the above regards are correct, the Wilson reference cannot anticipate Claim 20 of the present application.

Claim 20 of the present application specifies that the control apparatus enables or disables reproduction “dependent on the result of determination by the first determination means”. As has just been shown, however, the control apparatus of the Wilson reference does not enable or disable reproduction of digital data by said reproducing apparatus dependent upon the result of determination by said first determining apparatus. Instead, according to the Examiner’s interpretation of the Wilson reference, the control apparatus therein shown **selects** the data to be output with reproduction apparatus specifying information on each channel **prior to** the generation (using the terms of pending Claim 20) of the determination result of the first determining means determining whether the reproduction apparatus is capable of reproducing the digital data from the reproduction apparatus ID information and the reproducing apparatus specifying information. In other words, contrary to the present invention, in the Wilson reference **all** of the information flowing through each of the channels **is defined from the outset (i.e. from its output from the headend)** to be only information that will be received by a presentation player/display having the matching ID information and in turn reproduced **without further control**. Therefore, contrary to Claim 20 of the present application, the data content of the channels is controlled **before** its output in one of the channels and a determination of which output channel carries data having apparatus specifying information matching the ID information of the presentation player/display is subsequently performed.

In view of the foregoing, Applicants respectfully submit that the Wilson configuration is clearly distinct from that of the present invention. To further clarify and more distinctly state this point (which has been before the Examiner throughout this prosecution and therefore does not constitute an new issue requiring further consideration and/or search), Applicants by the foregoing Amendment propose that independent Claims 20 and 25 of this application be amended so as to specify that the claimed reproduction apparatus also comprises a CPU controlling each of the claimed storage apparatus, first determining apparatus and control apparatus.

Applicants respectfully submit that the presently proposed amendment makes it clear that the data to be reproduced is data that is present within the reproduction apparatus (i.e., the CPU or a specified external storage), rather than data that is normally present at the stream data sources on the opposite side of the distribution server from the reproduction apparatus (i.e., the claimed reproduction apparatus does not include an external data distribution system). As noted in the present specification, the effects of this are that improper copying of digital data by a user of the reproduction apparatus is less likely than otherwise. This is because it is not preordained in the present invention that each set of output data selected (i.e., in Wilson's contemplation inserted into one of the channels at the headend) can be reproduced by a specified reproducing apparatus operating as a distinct unit relative to the distribution system without further control. In addition, the digital data displayed by the user in the present invention also can be backed up by the user, a feature not available in the Wilson reference unless one assumes that the user records the data in the form in which it is sent to his TV for viewing (i.e., Wilson does not disclose any local data storage associated with his presentation player or his display television from which the data is available for backup storage).

Furthermore, even if a user did copy the data as it was displayed on the Wilson television display, that copied data would not include information specifying the apparatus that is capable of reproducing that data. This is because the so-called "presentation players" receive the data from a channel that has been locked onto as transmitting data including apparatus specifying information matching the ID associated therewith, convert the received data into data suitable for display by the display device and output the converted data to the display. Hence, improper copying (backup) of such converted data (i.e., copyright violations and the like) would not be precluded in the Wilson context. This is because the converted data copied would not contain the embedded reproduction apparatus specifying information required to be matched with reproduction apparatus ID information prior to copying.

Improper backup copying in the context of the present invention, however, remains precluded by virtue of the embedded apparatus specifying information contained in the information present in the backup storage apparatus.

Several other specific deficiencies in the currently outstanding Final rejections also are important to mention in these Remarks.

First, Claim 22 calls for an ID information input apparatus that is responsive to a determination by the first determination apparatus that the reproducing apparatus is not a reproducing apparatus capable of reproducing the digital data. The Examiner suggests that this is disclosed at least at Column 2, lines 34-58 (of which lines 39-41 appear to be the most relevant) of the Wilson reference. Applicant respectfully submits, however, that neither the portion of the Wilson reference particularly referred to by the Examiner, nor any other portion thereof, discloses the features claimed in present Claim 22. Indeed, while the Wilson reference discloses that the user is provided options for browsing the site accessed by the telephonic input of a code associated with the user, there is no indication or suggestion in the Wilson reference that this is done **in response to a failure of apparatus specifying information to match unique apparatus ID information.**

Second, with respect to Claim 23, it is noted that Claim 23 is dependent upon Claim 22. Accordingly, the failure of the Wilson disclosure with regard to the elements of Claim 22 applies to Claim 23 as well. Further nothing in the Wilson reference supports the Examiner's conclusion that the control apparatus enables or disables reproduction of the digital information by the reproducing apparatus **dependent upon the result of determination by the second determining apparatus.** The ID information input apparatus is for inputting ID information when the first determining apparatus indicates that the reproduction apparatus specifying information does not match the reproduction apparatus ID information.

This does not occur in Wilson because the basic premise of Wilson is that all information output with particular reproduction apparatus specifying information has already been determined to be reproducible on the user display associated with the presentation player that locks onto the channel carrying that output signal. Hence, Wilson does not contemplate that the user will input different ID information into the presentation player. Rather, Wilson contemplates that either a different presentation player will be chosen to lock onto the channel carrying the particular apparatus specifying information or that non-matching apparatus specifying information would never be embedded in the output channels from the headend.

Claim 24 is directed to an update selecting apparatus that allows the user to select whether or not the reproducing apparatus specifying information is to be updated by input reproducing apparatus ID information. The Wilson reference does not disclose this feature, at least at Column 21, lines 5-42 as indicated by the Examiner. Again this is not surprising because the basic premise of the Wilson reference is that the reproduction apparatus specifying information associated with the output from the server will always match the ID information associated with the presentation player servicing the desired user's display.

Finally, Applicants respectfully submit that the Wilson reference fails to disclose an external storage medium to which an external storage medium reading apparatus is mounted or external storage medium specifying information being included in the digital data such that the first determining means and the control apparatus function in the manner claimed in Claims 25 and 26. Claims 25 and 26 contemplate that the data has been acquired. On the other hand, the Examiner has indicated that the control apparatus claimed is equivalent to the distribution apparatus of the Wilson reference. Accordingly, it will be readily understood that the external storage medium referred to in Claims 25 and 26 is not the same thing as the stream data source referred to in Wilson's Claim 13, and consequently, that the external storage medium specifying information specifying an external storage medium claimed is not disclosed by the Wilson reference.

In view of the foregoing Amendment and Remarks, therefore, Applicants respectfully submit that the foregoing Amendment places this application in condition for allowance, or at least in better form for Appeal, as required by 37 CFR 1.116. Hence, reconsideration of this application and the allowance of Claims 20-28 in response to this communication are respectfully requested.

Finally, Applicants believe that additional fees are not required in connection with the consideration of this response to the currently outstanding Official Action. However, if for any reason a fee is required, a fee paid is inadequate or credit is owed for any excess fee paid, you are hereby authorized and requested to charge and/or credit Deposit Account No. **04-1105**, as necessary, for the correct payment of all fees which may be due in connection with the filing and consideration of this communication.

Respectfully submitted,

Date: August 6, 2004

By: David A. Tucker

David A. Tucker
Reg. No. 27,840
Attorney for Applicant(s)

EDWARDS & ANGELL, LLP
P.O. Box 55874
101 Federal Street
Boston, MA 02205
(617) 517-5508
453818